

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Luo, et al.

Serial No.: 10/623,968

Group Art Unit: 1615

Filed: July 21, 2003

Examiner: KENNEDY, Sharon E.

For: TRANSFER-RESISTANT COSMETIC

RESPONSE TO RESTRICTION

Commissioner For Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Communication dated August 3, 2006, the Applicants elect, with traverse, the invention of Claims 1-19, drawn to a composition.

The Examiner alleges that claims 1-19, drawn to a composition, and claims 20-21, drawn to a method of use, are distinct from one another, since the inventions are related by product and process of use, and because "the product as claimed can be used in a material different process such as transdermal adhesives for application to the body in other areas beside the lips, use in cream, lotions etc."

When several inventions claimed are related and patentably indivisible as claimed, restriction is not proper (MPEP 808.02). Claims 20-21 are directed to methods of using a product for application to the lips. In particular, claim 20 calls for a method of achieving long wear of a lip product comprising application to the lips of a product comprising a reaction product of a silica dioxide, or a derivative thereof, with a organosiloxo resin having a viscosity of about 1000 to about 200,000cs, and a volatile carrier. Product claims 1-19 are directed to a composition for application to the lips comprising a reaction product of a silica dioxide, or a derivative thereof, with a

organosiloxyl resin having a viscosity of about 1000 to about 200,000cs, and a volatile carrier. The Applicants have the right to restate (i.e., by plural claiming) the invention in a reasonable number of ways (MPEP 706.03(k)). Claims 20-21, are directed to achieving long wear of a lip product by applying to the lips a product which is exactly the same product as that of lip product claims 1-19. Two sets of claims could not be more closely intertwined. Thus, the method claims and the product claims are indivisible and nondistinct from one another.

Moreover, the Applicants disagree with the Examiner's conclusion that "the product as claimed can be used in a material different process such as transdermal adhesives for application to the body in other areas beside the lips, use in cream, lotions etc." The application of the claimed composition to skin in areas other than the lips is not a material different process from that of applying the claimed composition to the skin of the lips. Both processes involve applying the composition to skin, and it is considered that both applications would achieve the identical result.

The restriction is subject to reconsideration and review as provided in 37 C.F.R. §1.143 and 1.144. Accordingly, the Applicants request reconsideration and withdrawal of the requirement for election.

A petition and the requisite fee for extension of time for two months is being submitted concurrently with this response.

Respectfully submitted,

Date: 10/16/06


Cynthia R. Miller, Esq. Reg. No. 34,678
Estée Lauder Companies
155 Pinelawn Road, Suite 345 South
Melville, N.Y. 11747
Tel. 631 414-6068